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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,328	03/25/2005	Stephen Britton	BRI0007U	8653
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MICHAEL MOLINS MOLINS & CO. SUITE 5, LEVEL 6 139 MACQUARIE ST SYDNEY NSW, 2000 AUSTRALIA			EXAMINER WEINSTEIN, LEONARD J	
			ART UNIT 3746	PAPER NUMBER
			MAIL DATE 06/25/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/529,328

**Applicant(s)**

BRITTON, STEPHEN

**Examiner**

LEONARD J. WEINSTEIN

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities:  
element 11 is referred as both a diesel engine and a diesel motor.
2. The examiner also notes that the specification discloses both a gearbox with an inlet passage (not shown) and a sump for receiving and dispensing oil. As best understood by the examiner the disclosure teaches that the outlet passage provides a path for oil that is splashed by the movement of gears to other parts of the gearbox. It is important that the specification include an express disclosure that the oil in the gearbox is in a closed circuit and never is permitted to leave a housing of the gearbox. The disclosure tends to suggest that the sump is a component of the instant invention that delivers oil to a gearbox. One of ordinary skill in the art may come to this conclusion but the absence of an express disclosure of this feature would present an issue and qualify as new matter since there would also need to be an express disclosure of an oil inlet. Without an express disclosure of an oil inlet for the gearbox, the gearbox would eventually run out of oil, however this element would be considered to be new matter.

Appropriate correction is required.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "12" has been used to designate both mounting plate 12 and access holes 72 (see figure 7). Corrected drawing sheets in

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compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### ***Claim Objections***

4. Claim 3 is objected to because of the following informalities: the recitation of "of each a stabilizing rail" is incomplete and will be considered to be --- of each of a stabilizing rail --- for proper clarity.
5. Claim 12 is objected to because of the following informalities: the recitation of "a mounting plate" does not differentiate the mounting plate of claim 12 from the "mounting plate" of claim 1. The "mounting plate" of claim 12 will be considered to be --- a second mounting plate --- for proper clarity and the office action on the merits that follows.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claims 1-14 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claim 1 recites the limitation "the diesel motor" in line 5. There is insufficient antecedent basis for this limitation in the claim.
9. Claims 9, 12, and 14 recite the limitation "the shaft." There is insufficient antecedent basis for this limitation in the claim. As best understood by the examiner each instance of "the shaft" will be considered to be --- the common shaft --- for clarity and the office action on the merits that follows.
10. Claim 14 recites the limitation "the thrust bearing." There is insufficient antecedent basis for this limitation in the claim. As best understood by the examiner "the thrust bearing" refers to and will be considered to be --- the vertical thrust bearing --- for clarity and the office action on the merits that follows.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1, 4, 7-9, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saxe et al US 1,840,257 in view of Randolph US 4,676,352.

Saxe teaches all the limitations as claimed for a self powered pump including:

**[claim 1]** a frame 5 which supports a mounting plate 40, a engine/motor (housed in element 6) that is mounted above the plate 40 and an output shaft 34 (via a pulley system) driving a centrifugal water pump 10 whose axis of rotation is horizontal; **[claim 4]**: a mounting plate 40 further comprises a rear facing cut-out portion 39 for accommodating the water pump 10.

Saxe fails to teach the following limitations that are taught by Randolph including: **[claim 1]** a pump (col. 1ll. 31-35) driven by a motor 2 having a vertical axis of rotation, as shown in figures 1 and 3, (examiner is referring to the motor of Randolph since it is the prime mover and the engine is a for backup use), a 90 degree gear box 11 that is driven by motor 2, an output shaft 61 of the 90 degree gear box 11 driving a pump (col. 1ll. 31-35) whose axis of rotation is horizontal; **[claim 7]** gear box 11 being a step-up type. **[claim 8]** a gear box 11 and pump (col. 1 ll. 31-35) share a common shaft 51 which passes between them; **[claim 9]** a common shaft 51 passes between the pump (col. 1 ll. 31-35) and gear box 11, one end of the shaft 51 having mounted on it a first spiral bevel gear 68 having a hub, the gear box 11 supporting the hub 27 in a bearing 68; **[claim 12]** a gear box 11 end of the common shaft 51 is also supported by a tapered roller bearing

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28, a main housing of the gearbox 11 having affixed to it a second mounting plate 75 which includes a well, space under plate element 75 accommodating oil tube element 135, for receiving a vertical thrust bearing 26 and 27; **[claim 13]** a well, space under plate element 75 accommodating oil tube element 135, also retains a radial thrust bearing, elements 110 and 111 via element 85 and 91 **[claim 14]** and the vertical thrust bearing, elements 26 and 27, supports a thrust collar 91 which is integral with the shaft 51. Randolph teaches that the configuration including a pump having a horizontal axis of rotation driven by a motor having a vertical axis of rotation by a series of gears intermeshed allows for a pump to be driven by multiple sources. This provides for pump that has a primary and backup source for a drive input. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify a mobile pump as taught by Saxe, to have drive inputs from both an engine and a separate motor having perpendicular axis's of rotation in order to provide a primary and backup means for pumping a fluid (col. 2 ll. 21-46).

14. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saxe et al US 1,840,257 in view of Randolph US 4,676,352, as applied to claim 1 above, further in view of Lucchi US 2002/0131872. A combination of the references as discussed teaches the limitations including (with reference to Saxe): **[claim 2]** a frame 5 comprises a pair of side rails (fig. 1) located below a mounting plate 40 and inclined uprights, vertical rods extending down from the a handle bar connected the frame/rails 5 via axles, which are attached to the side rails 5, and the side rails 5 supporting a pair or wheels, as shown in figure 1;

**[claim 3]** and side rails 5 mounted on a lower surface of each of a stabilizing rail, with rail supporting the back side of pump 10 and element 6. A combination of the references fails to teach the following limitation that is taught by Lucchi for a portable pump with uprights 11 supporting an instrument panel 12. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify of the uprights of a portable pump, as taught by Saxe, modified to have a vertical motor driving a pump through a gear box, as taught by Randolph, to have an instrument panel or a switch for turning on the power to the pump as taught by Lucchi, in order to provide a convenient means for controlling the portable pump (Lucchi - ¶ 0019).

15. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saxe et al US 1,840,257 in view of Randolph US 4,676,352, as applied to claim 9 above, further in view of Kobenson US 2001/0021351. A combination of the references teaches the invention including (with reference to Randolph) an input shaft 61 of the gear box 11 carries another spiral bevel gear 67 which meshes with the first spiral bevel gear 68, the rotation of the bevel gears (67,68). A combination of the references fails to teach the following limitation that is taught by Randolph for a gear box 1 wherein the rotation of a two bevel gears (3, 6) creates an oil spray which enters an outlet opening, via element 15, and which is delivered from that opening to other parts of a gear box 1 (Kobenson - ¶ 0017). It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute a gear box with an oil spray outlet path as taught by Kobenson for a gear box as taught by Randolph, incorporated into a



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modification to provide a vertical motor driving a pump of portable pump, as taught by Saxe, in order to lubricate components within the gear box/ gear pump (Kobenson - claim 2 and ¶ 0017).

16. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saxe et al US 1,840,257 in view of Randolph US 4,676,352, as applied to claim 1 above, further in view of Mishima et al. US 6,012,956. A combination of the references teaches the invention as discussed but fails to teach the limitations taught by Mishima including a portion of an output pump diverted, via element 69, to an engine 2. It would have been obvious to one having ordinary skill in the art to add a pump output passage to an engine or motor driving the engine as taught by Mshima to a portable pump, as taught by Saxe, modified to have a vertical motor driving a pump through a gear box, as taught by Randolph, in order to provide a cooling means for an engine (Mishima – col. 1 ll. 17-24).

#### ***Allowable Subject Matter***

17. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited on form 892 herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEONARD J. WEINSTEIN whose telephone

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number is (571)272-9961. The examiner can normally be reached on Monday - Thursday 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon Kramer can be reached on (571) 272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Devon C Kramer/  
Supervisory Patent Examiner, Art  
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/Leonard J Weinstein/  
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